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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,470	09/16/2003	Jan-Erik Ekberg	4208-4148	9617
27123	7590	01/23/2009		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
HO, HUY C				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
01/23/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

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# Office Action Summary

**Application No.**

10/662,470

**Applicant(s)**

EKBERG, JAN-ERIK

**Examiner**

HUY C. HO

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-11, 13-22, 24-30, 32-34, 36-38, 40, 41 and 43-51 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 2-11, 13-22, 32-34, 36-38, 43-46, 48, 49 and 51 is/are allowed.  
6) ☒ Claim(s) 24-30, 40, 41, 47 and 50 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Examiner's Patent Drawing Review (PTO-946)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/26/2008 has been entered.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 45 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-10 of copending Application No. 10/662,407. Although the conflicting claims are not identical, they are not patentably distinct from each other because combination of claims 1 and 5-10 of the copending Application No. 10/662,407 disclose and suggest claimed features in claim 45 of the current Application. The difference between the claims is that claim 45 of the current Application requires a response including bit codes indicative of the presence of a middleware software layer, while claim 1 of the copending Application requires a

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response indicative a presence of a middleware software. However, it would have been obvious to one skilled in the art at the time of the invention that any response would be presented by a communication apparatus by some codes consisting of bits.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 25-28, 47 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25-27 recite the limitations "the disclosed information and "the memory device" and claim 28 recites the limitation "the memory device". There is insufficient antecedent basis for these limitations in the claims.

Claims 47 and 50 recite "A computer program product executable in a computer system" and further "comprising a computer readable medium". It appears that the computer product at least includes a program executable in a computer system and a computer readable medium. Therefore it is not clear how the computer program product comprising a computer readable medium could be "executable" in a computer system since the product does not appear just to be a program per se. In examiner's opinion:

"A computer program product comprising a computer readable medium storing a program code executable in a computer system, said program code comprising:

program code for conducting...

program code for determining.. etc"

would be a better choice of wording for claims 47 and 50.

Appropriate correction is required.

*Allowable Subject Matter*

6. Claims 2-11,13-22,32-34,36-38,43-46,48,49 and 51 are allowed.
7. The following is an examiner's statement of reasons for allowance:

The prior art of record, i.e., Nidd (US 2002/0120750), Beck et al. (US 6,604,140), Hermann et al. (US 6,633,757) and Smith et al. (US 2003/0006911) in combination, neither teach nor suggest the claimed invention unique features, i.e., conducting an inquiry to discover at least one nearby device in an ad-hoc network providing an inquiry response including bit codes, determining whether any of the inquiry responses received includes a modified bit codes as an indication that said at least one nearby device may includes a middleware layer, said middleware layer comprising a middleware software for providing application and service discovery, in response to determining that a received inquiry response does not include the indication that said at least one nearby device includes the middleware layer, disregarding the inquiry response, in response to determining that a receiving received inquiry response includes the indication that said at least one nearby device includes a middleware layer, creating a wireless short-range connection to said at least one nearby device and initiating wireless message exchange with said at least one nearby device to conduct middleware-based application and service information exchange for determining whether at least one target device supporting a required application or service is accessible in the ad-hoc network, the required application and service information including distributed information, wherein the distributed information includes: at least one reference to a required service, an association between each reference and one of said at least one target device, and state information about said at least one target device, because: Nidd (US 2002/0120750), Beck et al. (US 6,604,140), Hermann et al. (US 6,633,757) and Smith et al. (US 2003/0006911) in combination neither teach conducting an inquiry to discover a nearby device in an ad hoc network providing an inquiry response including bit codes, determining whether any of the inquiry responses received includes a modified bit codes as an indication that said at least one nearby device

may includes a middleware layer, where the middleware layer comprises a middleware software for providing application and service discovery, in response to determining that a received inquiry response does not include the indication that the nearby device includes the middleware layer, disregarding the inquiry response, in response to determining that a receiving received inquiry response includes the indication that the nearby device includes a middleware layer, creating a wireless short-range connection to the nearby device and initiating wireless message exchange with the nearby device to conduct middleware-based application and service information exchange in the ad-hoc network.

Therefore, claims 2-11,13-22,32-34,36-38,43-46,48,49 and 51 are deemed allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY C. HO whose telephone number is (571)270-1108. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex V. Eisen can be reached on 571-272-7687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Huy C Ho/  
Examiner, Art Unit 2617

/Alexander Eisen/  
Supervisory Patent Examiner, Art Unit 2617